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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,877	02/10/2004	Todd Simpson	87239/00004	8796
27871 7590 02/04/2008 BLAKE, CASSELS & GRAYDON LLP BOX 25, COMMERCE COURT WEST 199 BAY STREET, SUITE 2800 TORONTO, ON M5L 1A9 CANADA			EXAMINER CHANKONG, DOHM	
			ART UNIT 2152	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/774,877

Applicant(s)

SIMPSON, TODD

Examiner

Dohm Chankong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1> Claims 1-13 are canceled by Applicant in a preliminary amendment filed on 8/1/2006.

Claims 14-56 are added and are presented for examination.

2> This is a non-final rejection.

Specification

3> The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

4> In addition, the specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the "computer readable medium" in claims 52-56 lacks proper antecedent basis in Applicant's specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5> Claims 14-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The current position of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for software claims is that software *per se* does not

fall into any of the statutory categories. That is, software *per se* is neither a process, a machine, a manufacture, or a composition of matter.

Independent claim 14 is directed to "an e-mail system" that comprises a sender agent and a receiver agent. In discussing these elements, Applicant's specification discloses that "an agent can be any software system" [pg. 5, 0025]. Thus, claim 14 is directed merely to software *per se* and do not contain subject matter that falls within a statutory category.

Additionally, the claim is directed to the abstract idea of utilizing a sender and receiver agent to transmit and receive messages while negotiating a category for the messages. Abstract ideas can be saved from statutory oblivion if they recite a practical application. Practical applications can be provided by either a physical transformation or a useful, concrete, and tangible result. Here, there is clearly no physical transformation that results of applying the abstract idea. However, the result of sending and receiving messages while negotiating a category for the message provide a useful, concrete, and tangible result in the form of a categorized message.

Thus, claim 14 is rejected under 35 U.S.C §101 as failing to fall within a statutory category. As to claims 15-23, they do not cure any of above cited deficiencies of claim 14 and are therefore rejected for at least the same reasons set forth for claim 14.

Independent claim 24 is directed to a system that comprises a negotiation module that includes both the sender and receiver agents. For the same reasons discussed with respect to claim 14, claim 24 is also rejected under 35 U.S.C. §101 as failing to fall within a statutory category. As to claims 25-36, they do not cure any of the above cited deficiencies of claim 24 and therefore are rejected for at least the same reasons set forth for claim 24.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6> Claims 14-17, 20, 23, 37-42, and 47-56 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schiavone et al, U.S Patent Publication No. 2002|0120600 ["Schiavone"].

7> As to claim 14, Schiavone discloses an e-mail system for exchanging messages among users of the system, the system comprising:

a sender agent for transmitting a message from a sender to a receiver, the sender agent having access to a list of categories [0062 : Schiavone's mailing software 170 reads on Applicant's claimed sender agent | 0026 : senders "share knowledge of a common set of message type specifiers" where Schiavone's specifier reads on Applicant's claimed category]; and

a receiver agent for receiving the message, the message, the receiver agent recognizing the listing of categories [0064 : the "recipient's communication device 150" reads on Applicant's claimed receiver agent | 0026].

wherein the sender agent and receiver agent negotiate a category based on the list of categories for associating the category with the message [0035 | 0062 : receiver sharing knowledge with the mailing software and the mailing software selecting a mail-type specifier based on a list of shared specifiers].

8> As to claim 15, Schiavone discloses the negotiated category belongs to the listing of categories [0062 : "list of shared specifiers"].

9> As to claim 16, Schiavone discloses the negotiated category is mapped from one of the categories belonging to the listing of categories [0062 : negotiated specifier is selected from the list].

10> As to claim 17, Schiavone discloses the negotiated category is a new category added to the listing of categories [0025 : Schiavone discloses scanning the text of the message and creating a new specifier based on the text of the message. Thus, the specifier is newly added].

11> As to claim 20, Schiavone discloses an intermediary agent, wherein the listing of categories is provided to the sender agent through the intermediary agent [0026].

12> As to claim 23, Schiavone discloses a user interface for presenting the listing of categories to the sender to select the category therefrom [0025 : specify a mail type specifier by selection from a menu].

13> As to claims 37 and 52, as they do not teach or further define over the limitations of claim 14, claims 37 and 52 are rejected for at least the same reasons set forth for claim 14.

14> As to claim 38, as it does not teach or further define over the limitations of claim 15, claim 38 is rejected for at least the same reasons set forth for claim 15.

15> As to claims 39 and 54, as they do not teach or further define over the limitations of claim 23, claims 39 and 54 are rejected for at least the same reasons set forth for claim 23.

16> As to claim 40, as it does not teach or further define over the limitations of claim 16, claim 40 is rejected for at least the same reasons set forth for claim 16.

17> As to claims 41 and 53, as they do not teach or further define over the limitations of claims 16 and 17, claims 41 and 53 are rejected for at least the same reasons set forth for claims 16 and 17.

18> As to claim 42, as it does not teach or further define over the limitations of claims 20 and 21, claim 42 is rejected for at least the same reasons set forth for claims 20 and 21.

19> As to claim 47, Schiavone discloses a method of transmitting a message to a receiver for a sender in a message exchange system, the sender having a sender agent for sending the

message and the receiver having a receiver agent for receiving the message, the sender agent having access to a listing of categories recognized by the receiver agent [see rejection of claim 14], the method comprising:

obtaining a destination address from the sender for identifying the receiver and the receiver agent [0023 – use of an the receiver's email address];

receiving information from the sender to be included in the message [0025 – specifier based on content];

negotiating a category with the receiver agent based on the information and the listing of categories [0026];

associating the category with the message [0025]; and

transmitting the message to the receiver agent, the message being associated with the category [0024, 0025].

20> As to claims 48-51, as they do not teach or further define over the limitations of claims 15-17 and 20, claims 48-51 are rejected for at least the same reasons set forth for claims 15-17 and 20.

21> As to claims 55 and 56, Schiavone discloses inserting an indication of the category in a section or header of the message [0024].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22> Claims 18, 19, and 44-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schiavone, in view of Schiavone et al, U.S Patent Publication No. 20020120748 ["Koenig"].

23> It should be noted that Koenig describes additional aspects of Schiavone's invention. Schiavone makes explicit reference to the Koenig application [0068 : "Selective Delivery and Forwarding of Electronic Mail"]. Therefore, it would have been clear to one of ordinary skill in the art to have incorporated Koenig and Schiavone together to fully realize Schiavone's invention.

24> As to claims 18 and 19, Schiavone does not expressly disclose storing or indexing the message according to the negotiated category. However, describing an additional aspect of Schiavone's email system, Koenig discloses using the message specifiers (or identifiers) to store and index the email messages in a categorized inbox [0039 : specifiers including "personal", "business"].

25> As to claim 44, Schiavone does not expressly disclose storing the message together with an indication of the category associated therewith. However, Koenig describes this aspect of Schiavone's invention [0039].

26> As to claims 45 and 46, as they do not teach or further define over the limitations of claims 18 and 19, claims 45 and 46 are rejected for at least the same reasons set forth for claims 18 and 19.

27> Claims 21, 22, 24-26, 29-36, and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schiavone.

28> As to claim 21, Schiavone does not expressly disclose that the listing of categories is a union of a first listing provided by the intermediary agent and a second listing provided by the sender agent. However, Schiavone does disclose that the listing of categories is a result of shared "knowledge of a common set of message type specifiers" [0026]. The term "common set" is well known to refer to a set of items in common between two different sets. Thus, it would have been obvious for one of ordinary skill in the art to have reasonably inferred from Schiavone's use of the term "common set" that the listing of categories was a result of a union of message type specifiers provided by the sender and the third party.

29> As to claim 22, Schiavone does not expressly disclose a sender intermediary agent for communicating with said intermediary agent to negotiate said category. However, the

concept of distributing different functionalities between different network elements, such as from a sender to a sender's intermediary, is well known and obvious. Schiavone does disclose that his system can be implemented by spreading out different functionalities to multiple third party intermediaries [0066]. Thus, it would have been obvious to one of ordinary skill in the art to have implemented Schiavone with a sender intermediary agent to perform the sender's responsibilities.

30> As to claim 24, Schiavone discloses a system for classifying messages transmitted by a message exchange system, the message exchange system including a sending subsystem for transmitting a message from a sender to a receiver and a receiving subsystem for receiving the message, the system comprising:

a negotiation module for negotiating a category to be associated with the message and for maintaining a listing of categories [0064 : Schiavone's trust authority 200 reads on a negotiation module].

Schiavone also discloses a sender agent for determining the category from the listing of categories and a receiver agent for providing the sender agent with the listing of categories [0026, 0064, 0066] however Schiavone does not expressly disclose that the sender and receiver agents are included in the negotiation module. However, the concept of distributing different functionalities between different network elements, such as from a sender to a sender's intermediary, is well known and obvious. Schiavone does disclose that his system can be implemented by spreading out different functionalities to multiple third party intermediaries [0066]. Thus, it would have been obvious to one of ordinary skill in the art to

have implemented Schiavone with a sender intermediary agent to perform the sender's responsibilities.

31> As to claim 25, Schiavone discloses said sender agent having access to a listing of sender categories and is operative to deduce the category from the listing of categories maintained by the negotiation module and the listing of sender categories [0026, 0062 : "list of shared specifiers" : also see the rejection of claim 21].

32> As to claim 26, Schiavone discloses the category is a common category belonging to the listing of sender categories and the listing of categories maintained by the negotiation module [0026 : also see the rejection of claim 21].

33> As to claim 29, Schiavone discloses the message exchange system further includes a plurality of receiving subsystems for receiving the message for a plurality of receivers [0065], said negotiation module further including a plurality of receiver agents, each of said plurality of receiver agents being operative to provide said sender agent with a corresponding listing of categories [0026, 0066 : the recipient compliance engine as part of the negotiation module].

34> As to claim 30, Schiavone discloses establishing a common category for a subset of said plurality of receivers and to associate said common category with the message for said subset of receivers [0055].

35> As to claim 31, Schiavone discloses the use of one or more intermediary agents, said one or more intermediary agents having access to at least a separate listing of additional categories, and wherein the category is determined from a union of said separate listing of additional categories and the listing of categories [0026 : see rejection of claim 21 with respect to the concept of a "common set." Adding "additional categories" would have been obvious to one of ordinary skill in the art because a "common set" can refer to the union of multiple sets of items].

36> As to claims 32 and 34, Schiavone discloses one of said one or more intermediary agents is selected by said receiver agent or sender agent [0030 - selecting a trusted authority]. Schiavone does not expressly disclose that the agents select the authority. However, such a feature is implied by Schiavone's teaching that the sender and receiver have a shared common set of specifiers. This teaching implies that the sender and receiver have selected an intermediary to which to send their set of specifiers.

37> As to claim 33, Schiavone does not expressly disclose a search module for searching for an selecting said one or more intermediary agents. However, such a feature is implied by Schiavone's teachings that there can be more than one intermediary agent [0066 : trusted authority and/or another third party]. Since there are multiple intermediaries in Schiavone's system, it would have been obvious to one of ordinary skill in the art to have reasonably inferred the use of a method to search and select from one of the multiple intermediaries.

38> As to claim 35, Schiavone discloses presenting to a sender the listing of categories for the sender to select the category therefrom [0025 - menu].

39> As to claim 36, Schiavone discloses said negotiation module is configurable through the user interface to either negotiate the category free of interactive input from the sender or to receive an indication of the category from the sender through the user interface [0025 - sender selects a specifier].

40> As to claim 43, Schiavone discloses obtaining the listing of categories includes:
obtaining a first listing of a first plurality of categories from a first intermediary, retrieving a second list of a second plurality of categories from a storage location maintained by said receiver agent, producing the listing of categories from a union of the first listing and the second listing [0026, 0064]. Schiavone discloses that the listing of categories is a result of shared "knowledge of a common set of message type specifiers". The term "common set" is well known to refer to a set of items in common between two different sets. Thus, it would have been obvious for one of ordinary skill in the art to have reasonably inferred from Schiavone's use of the term "common set" that the listing of categories was a result of a union of message type specifiers provided by the sender and the third party. Additionally, Schiavone discloses the receiver storing public preference data at the recipient's data store while the sender retrieves categories from a trusted intermediary.

41> Claims 27 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schiavone, in further view of Gross et al, U.S Patent Publication No. 20040111478 ["Gross"].

42> As to claims 27 and 28, Schiavone does not disclose the category belonging to one of the two listings and is mapped or is a new category to a second category belonging to the other of the two listings. However, such a feature was well known in the art at the time of Applicant's invention. For example, Gross discloses the feature. Specifically, Gross discloses selecting a category from a receiver listing and mapping it (of adding a new category) to a sender listing and allowing the sender to use the category specified by the receiver listing [0010, 0217]. It would have been obvious to one of ordinary skill in the art to have modified Schiavone's email system to include Gross' teachings of mapping new categories to a sender. Enabling the receiver to specify the categories used by the sender gives a receiver more control over emails that are sent.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Ziv et al, WO 9964972 A2 - pg. 4, lines 13-24 : providing receiver defined categories for selection by the sender;

Shaw et al, U.S Patent No. 6,282,565 - col. 7 «lines 9-63» : categorizing emails;

Haneda et al, U.S Patent No. 6,560,638 - Fig. 4;

Fink, U.S Patent Publication No. 20030101227 - Fig. 7 - an intermediary with categorization;

Benowitz et al, U.S Patent Publication No. 20030236847 - 0086 - using negotiated "codes" to categorize emails;

Malik, U.S Patent No. 7.133.898 - column 2 «lines 1-40» - requiring some senders to register and receive a code to send emails to receivers;

Fung et al, U.S Patent No. 7.237.009 - column 2 «lines 52-67» - sender and receiver defined category IDs.

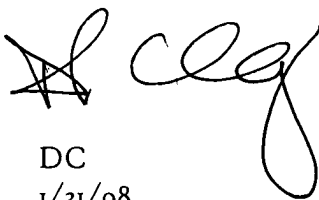
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Handwritten signature and initials. The signature appears to be "CEG" and the initials to the left are "AS".

DC
1/31/08